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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,098	12/18/2001	David A. Witt	END-805	5974

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EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 11/03/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,098

Applicant(s)

WITT ET AL.

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3731

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 1 (for example) defines the member upon which the clamp arm is pivotally mounted as being a "housing". However, the specification indicates that the member upon which the clamp arm is pivotally mounted is outer tube 160 while the "housing" is member 130. The clamp arm is not pivotally mounted on housing 130. Claim 1 (for example) indicates that the clamp arm is pivotable with respect to the end effector. However, the specification defines the end effector 180 as including the clamp arm (page 16, lines 13-20).

Claims 1-6, 9-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (5,873,873) in view of Tovey et al. (5,489,292). Smith et al. show housing 160, ultrasonic waveguide 180 having end effector 180', clamp arm 191, clamp pad 192 and actuating element 170. Smith et al. fail to show at least one hole in the clamp arm. However, Tovey et al., in col. 13, lines 53-67 and figures 20-23, teach that a clamp arm 232 (figure 23) for a surgical instrument should have at least one hole 238 therein in order to enhance its gripping ability. Including such holes in the Smith et al. clamp arm 191 and clamp pad 192 so

Art Unit: 3731

that it too would have this advantage would have been obvious. The Smith et al. clamp arm 191, when so modified, would have a top surface (the surface facing away from end effector 180') and bottom surface (the surface facing towards clamp pad 192) comprising at least one engaging surface (the surface of clamp arm 191 which would surround each hole and which engages the clamp pad). Further, the Smith et al. clamp pad 192 would have a surface (the surface which faces and engages the clamp arm 191) supported by the engaging surface. As to claim 2, Tovey et al. show a slot (between ribs 222) extending from the proximal end (portion) of the clamp arm distally into the clamp arm. This slot would be incorporated into the Smith et al. clamp arm 190. As to claim 3, Smith et al. fail to show the distal portion of the clamp arm as being curved. However, it is well known in this art to include a proximal straight section and a distal curved section in surgical jaws or clamp arms in order to reach certain tissues. It would have been obvious to so shape the Smith et al. clamp arm so that it too would have this advantage. As to claim 4, the Smith et al. clamp arm 191, when modified as set forth above, would have a plurality of engaging surfaces (the surfaces of clamp arm 191 which would surround the holes and which engages the clamp pad).

Art Unit: 3731

Claims 7, 12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (5,873,873) in view of Tovey et al. (5,489,292) as applied to claims 1-6, 9-11 and 13-15 above, and further in view of Fogarty et al. (3,503,398). Smith et al. fail to show a T-shaped slot in the clamp arm 191. However, Fogarty et al. teach that a clamp arm should include a T-shaped slot (e.g. 25, 26) in order to receive a corresponding shaped portion (e.g. 35, 36) of a pad for the clamp arm, in order to removably and yet positively secure the pad onto the clamp arm. Including such a T-shaped slot in the Smith et al. clamp arm 191 in order to removably and yet positively secure the pad 192 thereon would have been obvious for this reason.

Applicant's arguments filed Oct 21, 2003 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

Art Unit: 3731

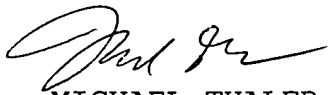
period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and (703)872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
October 31, 2003


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731